

REMARKS

Claim 1 was amended for clarity, not for purposes of avoiding the references cited by the Office. Claim 7 was amended for clarity in view of the amendment to claim 1. Claims 12-20 are new.

The Office rejected independent claim 1 under 35 U.S.C. 103(a) as being unpatentable over Ahlstone (U.S. Patent 5,207,495) in view of Knutson (U.S. Patent 5,295,742). Specifically, the Office asserts that Ahlstone '495 discloses each of the limitations of claim 1 except for a divider disposed within the carry case. The Office asserts that Knutson '742 discloses such a divider within a portable craft tools container. Based on these assertions, the Office concludes that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the lightbox of Ahlstone '495 to incorporate the divider system of Knutson '742 "to ensure a compact, portable organized and convenient graphic arts box that sustains a user's equipment during travel." Applicants respectfully traverse this rejection on the basis that these two references fail to establish a *prima facie* case of obviousness.

"In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art." *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); *In re Oetiker*, 24 U.S.P.Q. 2d 1443, 1447 (Fed. Cir. 1992); 35 U.S.C. § 132. "The patent applicant may then attack the Examiner's *prima facie* case determination as improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness." *In re Fritch*, 23 U.S.P.Q. 2d at 1783. "[T]he presence or absence of the *prima facie* case of obviousness controls the need for the applicant to adduce rebuttal evidence of unobviousness." *In re Dillon*, 16 U.S.P.Q. 2d 1788, 1788-89 (Fed.

Cir. 1990) (en banc) (Newman, J., dissenting) (citing *In re Johnson*, 747 F.2d 1456, 1460 (Fed. Cir. 1984).

To establish its *prima facie* case of obviousness the Office must identify "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings in the references." *In re Fritch*, 23 U.S.P.Q.2d at 1783. The Federal Circuit has held that "[t]he factual inquiry whether to combine references must be thorough and searching", and "[i]t must be based on objective evidence of record." *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). Additionally, "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed." *Id.* (citing *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Ahlstone '495 patent discloses a lightbox having a tool tray disposed on the outside of the carrying case (See FIGS. 1 and 10 showing grooves 118 and well 123 in relation to top cover 110 disposed over the diffuser plate 63). Knutson '742 is not even a lightbox. Rather, Knutson '742 is a craft tool box having an interior divider system. Thus, Knutson is directed to a completely different field of art from Applicant's claimed invention and is directed toward a problem unrelated to that which Applicant's invention is directed. The Office fails to set forth an adequate showing that one of ordinary skill in the art would even be motivated to look to Knutson '742 reference to combine its teachings with Ahlstone '495 when Ahlstone '495 fails to even suggest the desirability of providing a portable lightbox with a removably disposable divider. "[T]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." *In re Fritch*, 23 U.S.P.Q. 2d at 1784; *Arkie Lures, Inc. v. Gene Larew Tackle*,

Inc., 43 U.S.P.Q. 2d 1294, 1297 (Fed. Cir. 1997) ("It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements."). It is submitted that the office is using improper hindsight by defining the problem solved by Applicant in terms of its solution, thus using Applicant's claimed invention as an instruction manual or "template" to pick and choose among isolated disclosures in the prior art to piece together the Applicant's claimed invention in order to render it obvious. Such a practice is improper. As held by the Federal Circuit:

Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness By importing the ultimate solution into the problem facing the inventor, the district court adopted an overly narrow view of the scope of the prior art. It also infected the district court's determinations about the content of the prior art. . . . By defining the inventor's problem in terms of its solution, the district court missed this necessary antecedent question, namely, whether the prior art contains a suggestion or motivation to combine references to form a trend.

Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 45 U.S.P.Q.2d 1977, 1981-82 (Fed. Cir. 1998); *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1383 (Fed. Cir. 1986) cert. denied, 480 U.S. 947 (1987) (It is legally improper to focus on the obviousness of the substitutions and differences between the claimed invention and the prior art rather than on the obviousness of the claimed invention as a whole relative to the prior art.).

In fact, it is submitted that Ahlstone '495 actually teaches away from a divider "removably disposable within the carrying case" as originally claimed by Applicant, because Ahlstone '495 only discloses a tool tray (123, 118) exterior of the cover plate 110. *See e.g., In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) (Teaching away in the art from going in the claimed direction is a per se demonstration of lack of prima facie obviousness); *In re*

Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983) (It is improper to combine references where the references teach away from their combination); MPEP § 2145 X.D.2.

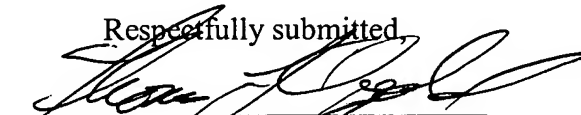
For the foregoing reasons, Applicant respectfully submits that the Office has failed to carry its burden of establishing a *prima facie* case of obviousness based on the cited references. Therefore, the Office's 103(a) obviousness rejection of claim 1 and all the other claims dependent therefrom (i.e. claims 2-11) should be withdrawn. Unless and until the Office carries its burden by citing references which make out a *prima facie* case of obviousness, the burden does not shift to Applicants to present any evidence of non-obviousness. *In re Dillon*, 16 U.S.P.Q. 2d at 1788-89.

However, even if the Office maintains its obviousness rejection based on the cited references, Applicant respectfully submits that claim 1 as amended for clarity overcomes the Office's obviousness rejection. Neither Ahlstone '495 nor any of the other references cited by the office disclose a divider removably disposable "**within an interior volume of the top portion of a carrying case**" as now claimed in amended claim 1. As such the Office's 103 obviousness rejection of claim 1 has been overcome. Because claims 2-11 are dependent from claim 1, then the Office's obviousness rejections of claims 2-11 have likewise been overcome.

For the foregoing reasons, Applicants respectfully request that a timely notice of allowance be issued in this case for all claims 1-20.

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Respectfully submitted,



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